

Practitioner's Docket No. 1142-001

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: James E. Selis

Application No.: 10/631,204

Group No.: 3773

Filed: 07/31/2003

Examiner: Tyson, Melanie Ruano

For: BIOPSY DEVICES AND METHODS

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**PETITION AND REQUEST FOR WITHDRAWAL OF FINALITY REQUIREMENT AND
RESPONSE TO OFFICE ACTION UNDER FINAL IN THE ALTERNATIVE**

This is a response to the Office Action mailed June 25, 2008. Foremost this document petitions and requests withdrawal of the finality requirement. In the event that the finality requirement is maintained, then Applicant requests the Office to please amend the above-identified application as follows and consider the following remarks.

Petition and Request for Withdrawal of Finality of Office Action

Under the circumstances of the present application, it is unfair and unjust to maintain the finality of the present Office Action. The Examiner is reminded that the Hoyns patent already has been examined at length previously. The present rejection is not a new ground of rejection, but rather an old one for which the Office has made findings already, pursuant to which the Office closed examination and allowed the application¹. In the Office Action mailed March 6, 2007, the Examiner expressly indicated allowance, and set forth reasons due to the absence of teachings in the Hoyns patent. The Hoyns reference had been discussed at length with the Examiner, and the Examiner's supervisor. Thereafter, in reliance upon the thorough examination already conducted, Applicant paid the issue fee. The current reinstatement of that reference accordingly is an unforeseeable circumstance to Applicant. Applicant should not be penalized through the finality of this Office Action, for having relied

¹ The Office then arbitrarily withdrew the rejection and, without any reliance upon Hoyns (then considered a dead issue by Applicant), the Office rejected the claims upon a newly located reference. Applicant thereafter interviewed the application and has overcome that rejection. Now, faced with Applicant having overcome the new rejection, the Office arbitrarily seeks to re-cant its prior position that Hoyns was overcome, and reinstate it against claims that are yet even further delimited from the claims originally allowed over Hoyns.

upon the past Office determination of patentability over Hoyns. Under the circumstances of this case of an individual inventor with finite resources, and given the mistake that the Office now appears to assert that it made, withdrawal of the finality requirement is appropriate.

In short, Applicant's amendment did not necessitate this rejection; rather, a series of inconsistent Patent Office actions did. Accordingly, Applicant respectfully requests withdrawal of the finality requirement so that Applicant may have a fair opportunity to address this ground of rejection.